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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,818	10/11/2005	Bernhard Gleich	DE 030118	5552
24737 7590 05/12/2010 PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510				
EXAMINER				
DEJONG, ERIC S				
ART UNIT		PAPER NUMBER		
1631				
MAIL DATE		DELIVERY MODE		
05/12/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/552,818

Applicant(s)

GLEICH, BERNHARD

Examiner

ERIC S. DEJONG

Art Unit

1631

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 36-40 is/are pending in the application.
- 4a) Of the above claim(s) 6, 8, 9 and 12-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 10, 11, 15-19, and 36-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED OFFICE ACTION

Applicant's responses filed on 10/29/2009 and 02/08/2010 are acknowledged.

Election/Restrictions

Claims 1-19 and 36-40 are pending.

Applicant's election without traverse of Hard-Magnetic Particles for the First required Species election (claims 10 and 11) and Thermoplastic Polymers for the Second required species election (claims 36 and 37) in the reply filed on 02/08/2010 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 20-35 are cancelled. Claims 6, 8, 9, and 12-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species for the First Species election requirement, there being no allowable generic or linking claim. See the Restriction Requirement mailed 01/07/2010. Further, dependent claim 3 has been examined only to the extent of the elected species of examination objects, a Thermoplastic Polymer. Election was made without traverse in the reply filed on 02/08/2010. Claims 1-5, 7, 10, 11, 15-19, and 36-40 are currently under examination.

Withdrawn Claim Rejections - 35 USC § 112

The rejection of claims 1-19 under 35 USC 112, 2nd paragraph, as being indefinite is withdrawn in view of amendments made to the instant claims.

Withdrawn Claim Rejections - 35 USC § 102

The rejection of claims 1 under 35 USC 102(b) as being anticipated by either of Heldmann et al. or Wasterby et al. is withdrawn in view of amendments made to the instant claims.

Applicant's arguments with respect to the instant claims have been considered but are moot in view of the new grounds of rejection set forth below.

New Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5, 7, 10, 11, 15-19, and 36-40 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

The instant claims are drawn to a method for the spatially resolved determination of physical, chemical, and/or biological properties or state variable. The claimed process comprises the steps of introducing coated magnetic particles having a coating into a least part of an examination area, detecting signals derived from generating and

changing magnetic fields present in said examination area, and evaluation signals to obtain information the magnetic particles in the examination area.

However, the instant claims do not recite any particular improvement or resultant characteristic that is imparted to proteins generated by the instant method or how analysis of the resultant secondary protein sequences would be used to yield any useful information.

However, the instant claims are generic with respect to the particular physical, chemical, and/or biological property or state variable that that is under investigation. Further, the instant claims are silent with regards to the steps involved in evaluating and unspecified signal derived from varying magnetic field strengths in the presence of a magnetic particle. Therefore, fail to specify what useful information would necessarily result from practicing the instant claims.

The Court of Patent and Appeals has stated:

"Practical utility is a shorthand way of attributing "real-world" value to claimed subject matter. In other words, one skilled in the art can use a claimed discovery in a manner which provides some immediate benefit to the public." A 'use' to do further research is not considered a utility which provides an "immediate benefit" to the public.

Examples of situations requiring further research to identify or reasonably confirm a "real world" context of use, and which do not have utility under 35 USC 101, as set forth in MPEP 2107.01.1, include:

- (A) Basic research such as studying the properties of the claimed product itself or the mechanisms in which the material is involved', and
- (C) A method of assaying for or identifying a material that itself has no specific and/or substantial utility.

In the instant case, the claimed invention encompasses a process of basic research drawn to studying unspecified properties (physical, chemical, and/or biological or state variables) by means of unspecified evaluation process of signals derived from varying magnetic field strengths in the presence of a magnetic particle. The instant

claims fail to specify any particular property and, further, fail to specify the a particular series of steps for evaluating signals so as to obtain a meaningful evaluation of spatial distribution and/or particle mobility. As such, the instant claims do not result in an "immediate benefit" to the public. As noted in the utility guidelines (see Federal Register, December 21, 1999, Vol. 64, No. 244), basic research on a product to identify properties is an insubstantial utility (see page 6 of the Utility guideline training materials). Therefore, the instant claims lack a specific and substantial utility.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5, 7, 10, 11, 15-19, and 36-40 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a credible asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 5,543,174

US Patent 4,764,445

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC S. DEJONG whose telephone number is (571)272-6099. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie Moran can be reached on (571) 272-0720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ERIC S. DEJONG/
Primary Examiner, Art Unit 1631